

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed October 28, 2005. Applicant respectfully requests reconsideration and favorable action in this Application.

The drawings stand objected to under 37 C.F.R. §1.83(a) as not showing every feature of the invention specified in the claims. FIGURE 14 has been amended to show the midsole described in the specification but missing from the drawings. Support for the amendment to the drawings to show the midsole can be found at page, See page 29, lines 11-13, of Applicant's specification. Further support for a midsole can be found at page 22, lines 9-12, of Applicant's specification. No new matter has been added as a result of showing the midsole in the drawings. Applicant's specification clearly states that midsoles may be included in the shoe, used to separate an insole from an outsole, and have substantially planar surfaces. The midsole now shown in FIGURE 14 provides these features. Moreover, midsoles are well known by those of skill in the art as shown in the various prior art documents submitted by Applicant and cited by the Examiner and as taken by the Examiner as Official Notice in the Office Action. No unusual features have been attributed to the midsole provided in FIGURE 14 and described in Applicant's specification. Therefore, Applicant respectfully submits that the drawings are in accordance with 37 C.F.R. §1.83(a).

The Examiner has also objected to the drawings as reference numeral 824 is not shown at a substantially halfway point of the shoe. FIGURE 14 has been amended to show that reference numeral 824 coincides with the midpoint of the length of shoe 810 as provided in Applicant's specification at page 29, lines 16-20, therein.

The Examiner has requested a Replacement Sheet correcting the above identified errors. Applicant has provided the Examiner with an appropriate Replacement Sheet pursuant to the Examiner's request. Therefore, Applicant respectfully submits that the drawings are in accordance with 37 C.F.R. §1.83(a). For the Examiner's convenience, another Replacement Sheet is attached herewith.

Claims 2 and 10 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 2 and 10 provide additional language that emphasizes the structure provided by the claimed shoe. Therefore, Applicant respectfully submits that Claims 2 and 10 are in accordance with 35 U.S.C. §112, second paragraph.

Claims 1, 2, 10, and 11 stand rejected under 35 U.S.C. §102(b) as being anticipated by Lodispoto. Independent Claims 1 and 11 recite in general an upper, an insole being a single piece layer and having a forward toe section and a rear heel section, and a planar outsole where a surface of the rear heel section is closer to the outsole than a surface of the forward toe section. By contrast, the top member or insole 21 of the wooden shoe in the Lodispoto patent does not have a rear heel section surface 24 closer to an outsole 22 than a forward toe section 24a as provided by the claimed invention. The Lodispoto patent clearly shows a raised heel portion 28 that prevents a wearer's heel from being closer to a walking surface than a wearer's toes as required in the claimed invention. See the Abstract of the Lodispoto patent and the upwardly bent backend stretch 28. The Examiner bases the rejection on the statement that the heel portion 24 is thinner than forefoot portion 24a according to an observation of the figures in the Lodispoto patent. However, the Examiner does not address the forward toe section of the Lodispoto shoe that

is forward of position "a" which is thinner than front surface 24a. The point forward of position "a" is where a wearer's toes are found. Taking into consideration the elevation of back end stretch 28, there is no disclosure in the Lodispoto patent that the insole member 21 independently provides a rear heel section closer to an outsole than a forward toe section as provided by the claimed invention. In addition, the Lodispoto patent does not have a planar outsole as provided by the claimed invention. As clearly shown by the Lodispoto shoe, its outsole 22 has an upper surface that curves slightly upward at tip 31 and curves more upwardly at back end 30 to accommodate insole 21. The outsole 22 has a lower surface that includes a highly arcuated front end stretch 30a and an arcuated back end portion 30. Thus, neither surface of the outsole 22 of the Lodispoto patent is planar. Therefore, Applicant respectfully submits that Claims 1, 2, 10, and 11 are not anticipated by the Lodispoto patent.

Claims 1-5 and 10-13 stand rejected under 35 U.S.C. §102(b) as being anticipated by Snabb, et al. Independent Claims 1 and 11 recite in general an upper, an insole being a single piece layer and having a forward toe section and a rear heel section, and a planar outsole, where a surface of the rear heel section is closer to the outsole than a surface of the forward toe section. By contrast, the Snabb, et al. patent clearly discloses that its insole 24 is substantially flat both laterally and longitudinally from heel to toe and that the slope is provided by its outer sole member 20. See FIG. 2 and col. 3, lines 50-53, of the Snabb, et al. patent. Moreover, the outsole member 20 of the Snabb, et al. patent is not planar, going from right to left in FIGURE 2, as it has a 0° slope to location 29, a 3.5° downward slope to location 30, and rises again beyond location 30. Thus, the Snabb, et al.

patent fails to show an insole with a rear heel section being closer to a planar outsole than a forward toe section thereof as required in the claimed invention. With respect to Claim 4, the location indicated by reference numeral 29 in the Snabb, et al. patent is clearly shown in the forward toe area of its shoe as opposed to a midpoint of the shoe as provided in the claimed invention. Therefore, Applicant respectfully submits that Claims 1-5 and 10-13 are not anticipated by the Snabb, et al. patent.

Claims 1, 2, 10, 11, 15, 16, and 20 stand rejected under 35 U.S.C. §103(a) as being anticipated by Robinson. Independent Claims 1, 11, and 16 recite in general an upper, an insole being a single piece layer and having a forward toe section and a rear heel section, and a planar outsole where a surface of the rear heel section is closer to the outsole than a surface of the forward toe section. By contrast, the insole 30 of the Robinson patent is substantially planar and cannot provide a structure where a rear heel section surface is closer to an outsole than a forward toe section surface as provided by the claimed invention. The Robinson patent discloses a reverse wedge separate from its insole. Thus, the Robinson patent does not provide an insole structure that is a single piece layer having a surface of a rear heel section being closer to an outsole than a surface of a forward toe section as specified in the claimed invention. Moreover, there is no disclosure in the Robinson patent that its insole is removable as provided in Claim 15. Therefore, Applicant respectfully submits that Claims 1, 2, 10, 11, 15, 16, and 20 are not anticipated by the Robinson patent.

Claims 1-5, 8, 10-14, and 16-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson. Claims 1, 2, 10, 11, 15, 16, and 20 have already been shown above to be

patentably distinct from the Robinson patent. The Examiner now states that it would be obvious to integrally form the reverse wedge and the insole of the Robinson patent to achieve the insole of the claimed invention. However, the Examiner merely provides a subjective conclusory "it would have been obvious" reason that the Robinson patent could be modified to incorporate its reverse wedge into its insole. Without an improper hindsight reconstruction of the prior art based on the disclosure of the claimed invention, the Examiner has not provided any objective evidence to support the proposed modification of the prior art as has been proposed. Therefore, Applicant respectfully submits that Claims 1-5, 8, 10-14, and 16-20 are patentably distinct from the Robinson patent.

Claims 8, 14, and 16-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Snabb, et al. Independent Claim 1, from which Claim 8 depends; Independent Claim 11, from which Claim 14 depends; and Independent Claim 16 that includes similar limitations found in Independent Claims 1 and 11 have been shown above to be patentably distinct from the Snabb, et al. patents. Therefore, Applicant respectfully submits that Claims 8, 14, and 16-20 are patentably distinct from the Robinson and Snabb, et al. patents.

Claims 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson or Snabb, et al. Independent Claim 11, from which Claim 15 depends, has been shown above to be patentably distinct from the Robinson and Snabb, et al. patents. The Examiner has taken Official Notice that it is well known to allow insoles to be removable. Applicant respectfully requests the Examiner to cite a prior art document that supports an ability to remove the type of insole provided by the claimed invention. Therefore, Applicant

respectfully submits that Claim 15 is patentably distinct from the Robinson and Snabb, et al. patents.

Claims 1-5, 8, and 10-20 stand rejected under the judicially created doctrine of double patenting over Claims 1-6 of U.S. Patent No. 6,131,315 in view of either Lodispoto, Robinson, or Borgeas. U.S. Patent No. 6,131,315 only provides disclosure through FIGURE 10 and does not include a FIGURE 14 of the elected species or any disclosure associated therewith as provided in Applicant's specification. Thus, the elected species of FIGURE 14 is not disclosed in U.S. Patent No. 6,131,315. Moreover, Claims 1-6 of U.S. Patent No. 6,131,315 are directed to specific features associated with an outsole of a shoe whereas the claims of the present Application are directed to features associated with an insole of a shoe. The Examiner merely subjectively states that the references clearly suggest the proposed modification without any objective evidence in support thereof. The Examiner has not provided any objective evidence that an insole of U.S. patent No. 6,131,315 could be modified as proposed in view of either Lodispoto, Robinson, or Borgeas. Therefore, Applicant respectfully submits that the claimed invention is patentably distinct from the Examiner's proposed combination and a Terminal Disclaimer is not necessary in this Application with respect to U.S. Patent No. 6,131,315.

This Response to Examiner's Final Action is necessary to address the new grounds of rejection not previously stated by the Examiner. This Response to Examiner's Final Action could not have been presented earlier as the Examiner has only now provided different grounds of rejection not previously of record in this Application.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

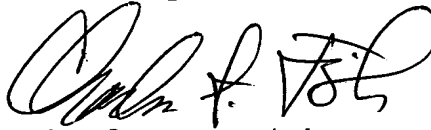
If there are matters that can be discussed by telephone to advance prosecution of this Application, Applicant invites the Examiner to contact the undersigned attorney at the number provided below.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

Attorneys for Applicant

A handwritten signature in black ink, appearing to read 'Charles S. Fish', with a stylized flourish at the end.

Charles S. Fish

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